

Claim Status

Claims 1, 3-6, 8-11, 13-16, 18-21 and 23-26 remain pending in the present application. Claims 1, 11 and 21 are independent claims.

Claims 1, 3-6, 8-11, 13-16, 18-21 and 24-26 were previously rejected as being unpatentable over UK Patent GB-2159461 (GB Patent) in view of U.S. Patent No. 1,428,278 (Dow). This rejection was set forth in the PTO's Final Rejection dated December 21, 2001 (see item 5 in the above Timeline).

Although not specifically addressed in the Final Rejection, Applicant presumes that claim 23 was intended to be similarly rejected.

Applicant respectfully traverses these previous rejections.

New Attorney Docket Number

Please change the docket number from "NIS0007" to --P0540--.

Applied Art References with Respect to Claim 1

Dow is newly cited as disclosing a document comprising a first printed matter in a first color and a second printed matter in a second color, wherein there is minimal contrast hiding second printed matter from a naked eye. See paragraph 4 of the Final Rejection. Applicant, however, does not understand Dow to teach or suggest Claim 1's recited combination of features.

Consider claim 1:

--1. (As previously amended) A document containing non-identifying and identifying information, said document comprising:

first printed matter rendered at a first location on said document and at a first scale enabling said first printed matter to be resolved by a viewing person without magnification;

second printed matter representing said first printed matter rendered at a second micro scale and at a second location on said document and in a second color, said second micro scale being significantly smaller than said first scale, said second location being spaced from said first location, and said *second color being selected to effect minimal contrast between said second printed matter in said second location and its immediate background, said minimal contrast hiding said second printed matter from the naked eye*; said minimal contrast effected by said second color constituting means for hiding said second printed matter from the naked eye; said second micro scale constituting means for rendering said second printed matter not ascertainable by the naked eye;

wherein said second printed matter is hidden, and cannot be perceived without magnification of the second micro printed matter; and

wherein said first and second printed matter conveys identifying information.-

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Applicant notes that the second color as recited in claim 1 is selected to effect minimal contrast between the second printed matter in the second location and its immediate background, the minimal contrast hiding the second printed matter from the naked eye.

In comparison, the cited passage of Dow teaches that different portions of a *figure* are printed with inks have the same color to the naked eye, but possessing different optical properties in another respect; for example, one portion [of the figure] is impressed with an ink consisting of a single color and another portion [of the figure] is impressed with an ink composed of a plurality of colors. See Dow at Col. 1, lines 41-51, and Figs. 2 and 3. The cited passage of Dow is not understood to teach or suggest selecting a second color to effect minimal contrast between a second printed matter in a second location *and its immediate background*, said minimal contrast hiding said second printed matter from the naked eye.

Moreover, Dow is not understood to apply its techniques to second printed matter representing first printed matter rendered at a second micro scale and at a second location on said document and in a second color, as recited in claim 1.

The GB patent does not remedy Dow's deficiencies in this regard.

The many other deficiencies of the proposed Dow and GB Patent combination are not belabored herein. (Applicant also respectfully questions the propriety of combining the proposed references as suggested in the Final Rejection.).

#### Remaining Claims

Independent claims 11 and 21 recite analogous features.

Applicant respectfully notes that the Final Rejection failed to meet its burden in specifically pointing out how the proposed combination of Dow and the GB Patent teach or suggest the inventive combinations as recited by the dependent claims. The dependent claims recite many additional, inventive combinations.

For example, the proposed art combination is not understood to teach or suggest that the second printed matter *consists of relatively dark toned text printed on a background color which is lighter toned than the text*, the light tone and said darker tone constituting a tone difference, the tone difference being selected to effect minimal contrast between the second printed matter in the second location and its immediate background (claim 4).

The proposed combination also is not understood to teach or suggest that the second printed matter consists of relatively *light toned text printed on a background color which is darker toned than the text*, the light tone and the darker tone constituting a tone difference, the tone difference being selected to effect minimal contrast between the second printed matter in the second location and its immediate background (claim 5).

Or, as recited in claim 8, the first and second printed matter comprise alphanumeric characters.

Still further please consider claim 9, in which the first and second printed matter comprises at least two digits of the year of birth of a person identified in the document.

Individual consideration of each of the dependent claims is requested.

#### **REQUEST FOR PERSONAL INTERVIEW**

Applicant respectfully requests an in person interview to discuss the present invention in view of the proposed combination of references.

The undersigned will contact the Examiner to schedule a convenient time. Should the Examiner pick up this Response prior to the scheduling of an interview, the Examiner is invited to contact the undersigned at 503-495-4575.

Favorable consideration and an early notice of allowance are requested.

Date: May 14, 2002



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Respectfully submitted,

DIGIMARC CORPORATION

By

A handwritten signature in black ink, appearing to read 'St SL'.

Steven W. Stewart

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Attachments: Change of Address  
Revocation of Power of Attorney